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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,294	01/16/2002	Brian Graham Taylor	12359	2323

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EXAMINER

BOCHNA, DAVID

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 06/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/046,294

Applicant(s)

TAYLOR, BRIAN GRAHAM

Examiner

David E. Bochna

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 7-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 7-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 7-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, it is unclear how the two axially extending portions can be both unthreaded (see line 3) and having mutually engaging threads (last line).

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al.

In regard to claim 1, Smith et al. (fig. 1) discloses a connector for connecting a first tubular 14 to a second tubular 12; the connector comprising a first portion 74 on the first tubular and a second portion 48 on the second tubular, wherein each tubular is provided with two axially extending unthreaded portions (74, 24 and 44, 66) which are load-bearing and allow the transfer of loads between the tubulars, and in the assembled connector are mutually parallel, wherein the

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first axially extending portion (74, 44) on each tubular is greater in length than the second axially extending portion (24, 66) on each tubular.

In regard to claim 7, the axially extending portions on each tubular are provided above and below the threaded portion.

In regard to claim 8, a spigot 32, 48 and a socket 74, 66 comprise the axially extending portions on each tubular.

In regard to claim 9, the spigot 32, 48 is provided between the tubulars' threaded face and terminus.

In regard to claim 10, the spigot 32 on the first tubular 14 engages the socket 66 on the second tubular 12.

In regard to claim 11, the spigot 48 on the second tubular 12 engages the socket 74 on the first tubular.

In regard to claim 12, the first tubular 14 comprises a pin connector.

In regard to claim 13, the second tubular 12 comprises a box connector.

In regard to claim 14, the socket 74 of the first tubular and spigot 48 on the second tubular 12 are greater in length than the socket 66 of the second tubular and spigot 32 of the first tubular.

In regard to claim 15, the axially extending portions are parallel to the axis of the tubulars.

In regard to claim 16, the first and second tubulars have a tapered profile 22, 38.

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In regard to claim 17, the tapered portions of the first and second tubulars are the threaded portions 22, 38 of the first and second tubulars and have co-operating tapers to facilitate mating of the two portions.

In regard to claim 18, Smith et al. discloses a method for connecting a first tubular 14 to a second tubular 12, wherein each tubular is provided with two axially extending unthreaded portions (74, 24 and 44, 66) in which the first axially extending portion (74, 24) on each tubular is greater in length than the second axially extending portion (44, 66) on each tubular, the method comprising the steps of:

gripping a first tubular 10 at a position spaced from its terminus;

inserting the axially extending unthreaded portions (74, 24 and 44, 66) on each tubular into corresponding recesses on the other tubular (by threading 10 and 14 together);

Engaging the first and second tubulars;

Gripping the second tubular; and

applying torque between the tubulars.

Response to Arguments

3. Applicant's arguments filed on 4/23/03 have been fully considered but they are not persuasive. Applicant argues that Smith et al. does not disclose that "each tubular is provided with two axially extending portions" where "the first axially extending portion on each tubular is greater in length than the second axially extending portion on each tubular" or "inserting the axially extending portions on each tubular into corresponding recesses in the outer tubular". However, the applicant fails to give an explanation as to why Smith et al. does not disclose these

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features. It is the Examiner's contention that Smith et al. does disclose these features, as explained in the prior art rejection above.

Applicant also argues that Smith et al.'s coupling focuses on the importance of cross-sectional area rather than the differences in length of its spigot/socket pairs. However, the focus of Smith et al.'s invention is irrelevant, as Smith et al. discloses all of the structural limitations recited by the applicant.

Applicant also goes on to explain some of the benefits and advantages of the present application. However, in response to applicant's explanation of the benefits and advantages, it is noted that the features upon which applicant relies (i.e., points (a), (b) and (c)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Bochna whose telephone number is (703) 306-9040.

The examiner can normally be reached on 8-5:30 Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H. Browne can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.



David Bochna
June 19, 2003